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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BROOKS KUSHMAN P.C./FGTL 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075-1238			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/681,815	Applicant(s) LEFKOWITH, DAVID	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 have been examined.

Response to Amendment

2. The Amendment filed on 1/14/05 is sufficient to overcome the Kanter and Elsmann reference.

Claim Rejections - 35 USC § 112

3. Claim 11, 12 recites the limitation leasing or renting an automobile to the customer. These claims are dependent upon independent claims 1. However, claims 1 disclose that the automobile has been sold to the customer. It is not possible to lease or rent the automobile after the automobile has already been sold. Claim 1 should state something like, providing an automobile to a customer wherein the automobile is acquired (similar to language in claim 13). Then, the dependent claims could state different ways of providing the automobile. However, as the claims are currently stated, there is insufficient antecedent basis for this limitation in the claim. Correction is required. Examiner notes that claim 1 was amended following the Examiner's recommendation in the earlier office action. However, this current recommendation, or a similar claim amendment, is necessary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

4. Claim 1-3, 6-10, 13-15, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Elsman (6,029,102) in view of Schulden (6,356,877).

Claim 1, 2, 13, 14: Kanter discloses a method, system for providing rebates to automobile owners based on purchases made at participating retailer locations, the method comprising: selling an item to a customer (col 16, lines 42-52) wherein the customer is provided with a customer identification badge containing a plurality of customer information (col 20, lines 50-57; col 17, lines 53-63); retrieving the customer information stored within the customer identification badge at a point of sale (col 16, lines 42-52); transmitting point of sale purchase information and the customer information to a rebate processing center remote from the point of sale (Fig. 1; col 16, lines 42-52; col 19, lines 18-22); and providing a rebate to the customer wherein the rebate is calculated based on the purchase information (col 16, lines 42-52).

Kanter does not explicitly disclose that the identification card is given to the user when the user is sold an automobile.

However, Elsman discloses providing an identification card at time of selling an automobile that includes user identifying information and can be utilized at time of future purchases (col 4, lines 5-15).

Elsman further discloses the utilization of a smartcard with memory (col 2, line 64-col 3, line 5; Fig. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Elsman's card provided at automobile purchase to Kanter's card provided when making a purchase at a sponsoring company location. One would have been

Art Unit: 3622

motivated to do this in order to allow Kanter's method to be utilized with sponsoring companies who are automobile dealers.

Additionally, Kanter discloses that awards can be set as valid or invalid:

“(79) (ii) to provide an incentive program which allows a sponsoring company to designate certain items of merchandise or certain services as valid or invalid toward posting awards and/or as valid or invalid for redemption of awards” (col 15, lines 30-35).

Elsman discloses verifying ownership of the automobile:

“(9) The authorization card may be generated by law enforcement authorities or the owner of the vehicle. In one embodiment of the invention, the owner may encode restricted authorization cards using the controller by first entering an appropriate password” (col 1, lines 61-67).

Schulden discloses that cards be utilized to record and provide awards and that awards can be stopped after a certain period of time and that awards are provided to vehicle owners:

“(14) Finally, another possibility is to issue the credit by means of a corresponding entry on a read/write storage medium such as a chip card or magnetic strip card. In this case, the credit can be redeemed at any location that accepts this card as a method of payment (col 2, lines 44-50).

(23) As another feature of the invention it is also possible that one of the communication devices supplies data regarding the time at which the advertising medium is attached to the vehicle. Namely, if the advertising company or an agency appointed by it always sets the contracts with the vehicle owners for a predetermined time period, then this data is enough to

Art Unit: 3622

determine whether the life of the contract has already expired and to possibly avoid issuing a credit after the life of the contract expires (col 4, lines 15-25) .

(16) Based on the data sent to it, the central control unit 30 determines whether or not the owner of the vehicle 12 is entitled to a credit with this filling station visit. For example, if a predetermined time period, e.g. one week, has passed since the last filling station visit and the contract between the vehicle owner and the advertising company has not yet expired, and furthermore if the advertising medium 16 is attached to the vehicle 12 in an intact state, then the control unit 30 determines that the owner of the vehicle 12 is entitled to a credit and transmits a corresponding signal to an automated payment point 32 by way of a signal line Z" (col 6, lines 22-33).

Notice that in Schulden that the user must be the owner and must be in possession of the vehicle. The user is verified as being in possession of the vehicle by verifying that an intact sticker is in place on the vehicle. Also, notice that in Schulden that the rebates expire after pre-determined time periods.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Kanter's card for acquiring rebates can expire based on differing criteria such as possession of a certain item such as an automobile. One would have been motivated to do this in order to provide incentives for purchasing certain items and rewarding certain user conditions or actions.

Claim 3, 15: Kanter and Elsmann and Schulden disclose the method of claim 1, and Kanter further discloses that the customer identification badge comprises a magnetically encoded wallet card (col 17, lines 53-60).

Claim 6: Kanter and Elsmann and Schulden disclose the method of claim 1, and Kanter further discloses that the rebate comprises a check mailed to the customer at quarterly annual time intervals (col 16, lines 47-52; col 25, lines 5-15). Furthermore, since Kanter states that any periodic time period, such as a month, is possible, it would be obvious that the time period can be quarterly. Quarterly payments are a convenient option to some users.

Claim 7, 18: Kanter and Elsmann and Schulden disclose the method of claim 1, and Kanter further discloses that the rebate is electronically deposited into a bank account specified by the customer (col 16, lines 47-52).

Claim 8, 19: Kanter and Elsmann and Schulden disclose the method of claim 1, and Kanter further discloses that the purchase information comprises a rebate amount that a participating retailer is willing to pay (col 16, lines 43-65; col 17, lines 60-63).

Claim 9, 20: Kanter and Elsmann and Schulden disclose the method of claim 1, and Kanter further discloses that the retailer provides payment to the rebate processing center to pay for the rebate (Fig. 1; col 19, lines 55-col 20, line 19).

Claim 10, 21: Kanter and Elsmann and Schulden disclose the method of claim 1. Kanter further discloses transmitting the customer information from the sponsoring company/ place where user became a member to the rebate processing center (Fig. 1; item 79).

5. Claims 4, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Elsmann (6,029,102) in view of Schulden (6,356,877) in view of Ovadia (5,612,527).

Art Unit: 3622

Claim 4, 16: Kanter and Elzman and Schulden disclose the method of claim 1. Kanter does not explicitly disclose that the customer identification badge comprises a bar code.

However, Ovadia discloses utilizing automobile related identification cards at time of purchase and also the utilization of bar codes and magnetic striping (col 6, lines 10-20).

Ovadia further discloses that the customer identification badge comprises a bar code (col 2, lines 15-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ovadia's customer identification badge with bar code to Kanter's customer identification badge with identification code. One would have been motivated to do this in order to provide a convenient way of identifying the user.

6. Claims 5, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Elzman (6,029,102) in view of Schulden (6,356,877) in view of Bricauld (6,149,466).

Claim 5, 17: Kanter and Elzman and Schulden disclose the method of claim 1. Kanter does not explicitly disclose that the customer identification badge comprises a persistent memory module having input and output capabilities wherein the module is attached to the automobile.

Kanter further discloses a sponsor providing a wide range of services and that the sponsor can operate in a wide variety of locations (Fig. 1; col 4, lines 39-41).

However, Bricauld (6,149,466) discloses a smartcard whereby the smartcard is attached to the automobile and there is also a module in the automobile for attaching the smartcard too

Art Unit: 3622

and the smartcard can be utilized for services in the automobile (col 1, lines 17-25; col 1, lines 10-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bricauld's card that can be utilized in an automobile to Kanter's card that can be utilized in a wide variety of locations. One would have been motivated to do this in order to allow flexible utilization of the card.

7. Claims 11, 12, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Elsman (6,029,102) in view of Schulden (6,356,877) in view of Schilling (5,359,182).

Claim 11, 12, 22, 23: Kanter and Elsman and Schulden disclose the method of claim 1. Kanter nor Elsman explicitly discloses that the automobile is leased or rented to the customer.

However, Schilling discloses the utilization of cards and that automobiles can be rented or leased (Fig. 1; Fig. 2; col 11, lines 21-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add automobile renting or leasing to Kanter's sponsoring company whereby the sponsoring company can be Elsman's automobile dealer. One would have been motivated to do this in order to utilize the full services of an automobile dealership such as selling, renting, and leasing automobiles.

Application/Control Number: 09/681,815
Art Unit: 3622

Response to Arguments

8. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that the 35 USC 112 rejection still applies to claims 11 and 12. Claim 1 states that the automobile is sold. Claims 11 and 12, dependent upon claim 1, state that the automobile is leased or rented. Correction is required.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Application/Control Number: 09/681,815
Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Arthur Duran
Patent Examiner
3/25/05


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PRIMARY EXAMINER